REMARKS

Claims 1-12 were examined. Claims 1, 2, 4, and 8-11 have been amended. Support for these amendments is identified in the following remarks. No new matter has been added by these amendments. Examination and reconsideration of all pending claims are respectfully requested.

Canceled and Amended Claims

Applicants have amended claims 1, 2, 4, and 8-11. Applicants do not abandon any of the subject matter made by the claim amendments or claim cancellations and herein reserve the right to reinstate or to file divisional/continuation applications directed to any of the subject matter that was originally filed.

Allowable Subject Matter

Applicants thank the Examiner for the indication that claims 2, 9 and 10 provide allowable subject matter. Applicants have corrected the perceived 35 U.S.C. §112, second paragraph rejections (as described below). Claims 9 and 10 have been made into independent form. Consequently, claims 2, 9 and 10 should be allowable.

Claim Rejections under 35 USC §112

Claims 2, 4, and 5 are rejected under 35 USC §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicants have amended claim 1 so that the preamble of the claim and the body of the claim are commensurate in scope. Applicants are intending to claim the subcombination of the "robotic surgical tool". To that end, Applicants have amended claim 2 to recite that the

sterile adapter is releasably mountable to the tool holder, and that the adapter is configured to couple the tool holder to the interface. Claim 2 should now be clear.

Applicants have amended claim 4 to replace "probe body" with "probe." Claim 4 should now be in condition for allowance. For the same reason, claim 5 should also be in condition for allowance.

Claim Rejections under 35 USC §102

Claims 1, 3, 4, 8, 11 and 12 are rejected under 35 USC §102(b) as being anticipated by Denon et al. Such rejections are traversed in part and overcome in part as follows.

To expedite prosecution, Applicants have amended claims 1, 8 and 11. Each of claims 1, 8, and 11 have been amended to recite that the interface comprises a portion of a drive system. The portion of the drive system is releasably coupleable with driving motors of the robotic surgical system. The cited references do not describe or suggest such elements.

Instead, Denen et al. merely illustrates in FIG. 1 an interface 13 that is in the form of a cable that connects to an external power supply and control apparatus. There does not appear to be any description or suggestion of a drive system or the interface being releasably coupleable to driving motors of a robotic surgical system.

For at least the above reasons, independent claims 1, 8 and 11 are allowable over the cited reference. For at least the same reasons, dependent claims 3-6 and 12 are also allowable.

Claim Rejections under 35 USC §103(a)

Claim 7 is rejected under 35 USC §103(a) as being unpatentable over Cooper in view of Denon et al. Claims 1, 4 and 5 are rejected under 35 USC §103(a) as being unpatentable over Cooper in view of Denon et al. Such rejections are traversed as follows.

The present application is a continuation-in-part of co-pending U.S. Patent Appl. No. 09/418,726 filed October 15, 1999, which claims the benefit of U.S. Provisional Patent Appl. No. 60/111,713 filed on December 8, 1998. This application is also a continuation-in-part of pending U.S. Patent Appl. No. 09/406,360 filed September 28, 1999, which is continuation of

U.S. Patent Appl. No. 08/975,617, filed November 21, 1997 (now U.S. Patent 6,132,368 - "the Cooper reference"), which claims the benefit of U.S. Provisional Patent Appl. No 60/033,321 filed on December 12, 1996.

The cited Cooper reference is the "grandparent" to the present application and was published less than 1-year before the filing date of the present application (i.e., the Cooper reference, if prior art at all, would be available as only a §102(e) reference). Because the present application was filed after November 29, 1999 and the present application and the Cooper reference were commonly owned at the time the invention was made, then under 35 U.S.C. § 103(c) the Cooper patent is not prior art to the present application. *See* MPEP § 2146 and 706.02(l)(1)-(l)(3).

Consequently, the rejections of claims 1, 4, 5, and 7 which rely on Cooper are not proper rejections under 35 U.S.C. § 103(c). Consequently, claims 1, 4, 5, and 7 should be in condition for allowance.

Double Patenting

Claims 1, 4, 6-8 and 11 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 6, 12, 15 and 17 of commonly owned U.S. Patent 6,331,181.

While Applicants do not agree that the pending claims of the present application are anticipated or obvious over the claims of the cited patent, to expedite prosecution, Applicants submit herewith a terminal disclaimer to overcome the obviousness-type double patenting rejection. As such, all pending claims should now be in condition for allowance.

CONCLUSION

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 206-467-9600.

Respectfully submitted,

Dated: 12/10/03

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